**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of )    MAIL STOP AF
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Application No.: 10/004,100 )    Examiner: Matthew D. Anderson
                                 )

Filed: October 31, 2001 )    Confirmation No.: 9371
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For:    DISK DRIVE AND METHOD FOR )
       USING A MAILBOX FILE ASSOCIATED)
       WITH A DISK STORAGE MEDIUM FOR)
       PERFORMING A FUNCTION )
       CHARACTERIZED BY CONTENTS OF )
       THE MAILBOX FILE )

## REQUEST FOR PRE-APPEAL BRIEF CONFERENCE

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

A Pre-Appeal Brief Conference is requested to review the above-identified application. No amendments are being filed with this request. For at least the following reasons, the rejections raised in the Final Office Action are clearly improper and without basis.

## OVERVIEW

Independent claims 1 and 12 are allowable over commonly assigned U.S. Patent No. 6,772,281 (Hamlin), because the Hamlin patent does not anticipate all features recited in these claims relating to use of a mailbox file. The Hamlin patent does not anticipate Applicant's claim 1 disk drive which includes, among other features, a mailbox file **executable under control of the disk drive**; and a disk controller that references the mailbox file to perform a **function characterized by contents of the mailbox file**. In addition, the Hamlin patent fails to anticipate claim 12 which relates to a method that includes, among other features, designating a mailbox file **executable under control of the**

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**contents of the mailbox file**. The rejection of independent claims 1 and 12 under 35

U.S.C. §102(e) as being anticipated by the Hamlin patent is therefore traversed.

## ARGUMENT

1.  The Hamlin patent fails to anticipate each and every element recited in independent claims 1 and 12

The present invention is directed to using a mailbox file on a disk storage medium of

a disk drive, wherein the mailbox file is executable under control of the disk drive. A

command can be responded by performing a function characterized by contents of the

mailbox file. These features are recited in the claims and are clearly lacking in the Hamlin

patent.

The Hamlin patent discloses a disk drive that is programmed to translate an address

received in a host read command, and in response, to return content to the host from a

different address. The boot sector code of the Hamlin patent, relied upon by the Examiner,

does not constitute a file which is executable under control of the disk drive, nor does the

disk drive perform any function characterized by **contents of the boot sector code**. As

such, the boot sector code of the Hamlin patent clearly cannot constitute Applicant's claimed

"mailbox file."

Applicant's exemplary Figure 1 embodiment illustrates a disk drive 100 that includes

a disk storage medium 106. As described in paragraph [0018] on specification page 7, at

least one of the addressable locations of a first range of host interface addressable locations

is used to designate a mailbox file. This portion of the specification describes that a mailbox

file is a functional file contained on the storage medium of a hard disk drive, the file being

executable under control of the hard disk drive.

Paragraph [0019] on specification pages 8-9, describes that disk controller 112

responds to a command from a host computer operating system that references the mailbox

file 120. The disk controller can respond by performing a function characterized by the contents of the mailbox file.

Paragraph [0020] on specification page 9, describes that because the computer hardware internal to disk controller 112 performs the function, the speed at which the function is performed is accelerated. Paragraph [0021] describes that the mailbox file 120 can contain any form of computer software code for performing any type of function and that the mailbox file can, for example, act as a "window" through which the host computer's operating system accesses a second range of addressable locations that are otherwise "hidden" from the disk drive host interface and operating system.

Claim 1 is directed to a disk drive which comprises, among other features, a disk storage medium having a first range of disk drive host interface addressable locations accessible by a host computer operating system. At least one of the addressable locations is used to designate a mailbox file **executable under control of the disk drive**. Claim 1 also recites a disk controller for responding to the command from the host computer operating system that references the mailbox file to perform a **function characterized by contents of the mailbox file**.

Claim 12 is directed to a method for accessing storage locations of a disk storage medium in a disk drive using a disk controller. Claim 12 recites that at least one of the addressable locations is used to designate a mailbox file **executable under control of the disk drive**. The claim 12 method recites a step of responding to a command from the host computer operating system by performing **a function characterized by contents of the mailbox file**.

Such features are not disclosed by the Hamlin patent, and this patent does not anticipate independent claims 1 and 12. The portions of the Hamlin patent cited by the Examiner in the final rejection of claims 1 and 12, describe translating a received address to achieve a different boot-up process in response to a particular host request.

Portions of the Hamlin patent relied upon in the Final Office Action, such as column 3, lines 1-7 and column 5, lines 39-50 merely describe programming of the disk drive to return a different sector of the disk drive during a boot-up process. The discussion at column 5, lines 48-51 in the Hamlin patent refers to the disk drive asserting autonomous control over the boot process. But these excerpts do not describe a "mailbox file" executable under control of the disk drive.

In the Hamlin patent, the disk drive asserts autonomous control over the boot process by substituting another sector's content for an expected boot sector content. However, the original boot sector code requested by the host computer does not constitute a mailbox file that is executable under control of the disk drive, as recited in claim 1. In addition, the disk controller in the Hamlin patent does not perform a function characterized by contents of the original boot sector requested by the host computer. As such, the disk controller does not respond to a command from the host computer operating system that references a mailbox file to perform a function characterized by contents of the mailbox file.

Claim 1 is therefore allowable. Independent claim 12 recites features similar to those discussed above with respect to claim 1 and is allowable over the Hamlin patent for similar reasons. All of the remaining claims depend from independent claims 1 and 12 and recite additional advantageous features which further distinguish over the Hamlin patent.
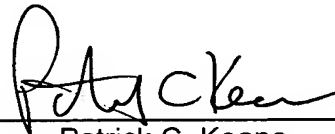
## CONCLUSION

The Examiner has not established that the Hamlin patent anticipates independent claims 1 and 12 of the present application. Therefore, these claims, along with all claims which depend therefrom, are allowable.

Respectfully submitted,

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